REMARKS

Claims 1-21 were pending and presented for examination. In an Office Action dated January 11, 2008, claims 1-21 were rejected. Applicants are amending claims 1, 2, 6-9, 12-14, 17, 18, 20 and 21 and canceling claim 15 in this Amendment and Response. After entry of this Amendment, claims 1-14 and 16-21 remain pending.

In view of the Amendments above and the Remarks that follow, Applicants respectfully request that Examiner reconsider all outstanding objections and rejections, and withdraw them.

Response to Rejection Under 35 USC 102(b)

In the 2nd paragraph of the Office Action, Examiner rejects claims 1-2, 7-12, 16 and 20-21 under 35 USC § 102(b) as allegedly being anticipated by U.S. Patent No. 6,123,258 to Iida et al. ("Iida"). This rejection is traversed.

Claim 1, as amended recites:

A method, comprising:
receiving, by a data processing system, an electronic document having printed and non-printed data contained in the electronic document;
analyzing, by the data processing system, the printed data;
analyzing, by the data processing system, the non-printed data;
triggering, by the data processing system, an action based the analysis of the printed and non-printed data; and
performing, by a printer, the action, wherein the action is selected from the group consisting of updating a database, sending an email, monitoring a use of fonts in the document, and monitoring a use of halftones in the document.

The features of the claimed invention are beneficial because the claimed features allow for analysis of a printed document, including analysis of printed and non-printed data contained in the document, and execution of an action in response to, and based on, the analyzed data. The action may be updating a database, sending an email, monitoring a use of

fonts in the document, and monitoring a use of halftones in the document. As claimed, a data processing system triggers particular actions based on the analysis of printed and non-printed data and performs those actions based on such analysis. The printed and non-printed data of the electronic document help to make up the characteristics of the document for later determination of what actions to perform.

Iida fails to disclose or suggest at least the features of "analyzing, by the data processing system, the printed data" and "analyzing, by the data processing system, the non-printed data." Iida also fails to disclose or suggest "triggering, by the data processing system, an action based the analysis of the printed and non-printed data." Iida merely describes receiving embedded data from a document. In Iida, the embedded data is selectively scanned and then supplied to a recognizing unit. *See* Iida, col. 10, lines 3-11. The recognizing unit then performs a recognition process and extracts embedded information. *See* Iida, col. 10, lines 11-17. The extracted information is then supplied to a control unit, which then performs a series of predetermined tasks, not an action based on printed and non-printed data of the document. *See* Iida, col. 10, lines 17-40. The information that is extracted and analyzed is merely the selected embedded information, and does not include any non-printed data contained in the document. As such, Iida does not disclose or suggest "analyzing, by the data processing system, the printed data" and "analyzing, by the data processing system, the non-printed data." Iida also fails to disclose or suggest "triggering, by the data processing system, an action based the analysis of the printed and non-printed data," as recited in claim 1. Therefore, for at least these reasons, the rejection of claim 1 under 35 USC § 102(b) based on Iida is improper and should be withdrawn.

Furthermore, Iida fails to disclose that the action may be updating a database, sending an email, monitoring a use of fonts in the document, and monitoring a use of halftones in the document. The actions described in Iida do not include any of the actions described above. Therefore, Iida also fails to disclose "performing, by a printer, the action, wherein the action is selected from the group consisting of updating a database, sending an email, monitoring a use of fonts in the document, and monitoring a use of halftones in the document," as recited in claim 1. Therefore, for at least these reasons, the rejection of claim 1 under 35 USC § 102(b) based on Iida is improper and should be withdrawn.

Claims 20 similarly "analyzing, by the data processing system, the printed data, analyzing, by the data processing system, the non-printed data," and "triggering, by the data processing system, an action based the analysis of the printed and non-printed data." Claim 21 similarly recites "analyzing, by the data processing system, the printed data, analyzing, by the data processing system, the non-printed data." All arguments advanced above with respect to claim 1apply equally to claims 20 and 21.

Additionally, as claims 2, 7-12 and 16 depend either directly or indirectly from the patentable independent claim 1 discussed above, all arguments advanced above with respect to independent claim 1 are hereby incorporated so as to apply to these dependent claims as well. In addition, claims 2, 7-12 and 16 recite other patentable features which further distinguish them from the prior art of record. Applicants submit that dependent claims 2, 7-12 and 16 are patentable over the prior art of record by reason of their dependency, in addition to the further patentable limitations recited therein.

<u>Response to Rejection Under 35 USC 103(a)</u>

The Examiner rejects claims 3-6 and 13 under 35 USC § 103(a) as allegedly being over Iida in view of Nickerson, US Patent No. 6,043,904 ("Nickerson"). This rejection is traversed.

As stated above, Iida fails to disclose or suggest at least the features of "analyzing, by the data processing system, the printed data, analyzing, by the data processing system, the non-printed data," and "triggering, by the data processing system, an action based the analysis of the printed and non-printed data."

Nickerson does not remedy the deficiencies of Iida. Nickerson merely describes a facsimile for communicating job status information that is capable of transmitting confirmation information. *See* Nickerson, abstract and col. 9, lines 20-26. Applicants respectfully submit that for at least these reasons claims 3-6 and 13 are patentably distinguishable over the cited references, both alone and in combination. Therefore, Applicants respectfully request that Examiner reconsider the rejection, and withdraw it.

The Examiner also rejects claim 14 under 35 USC § 103(a) as allegedly being over Iida in view of Ying, US Patent No. 6,853,980 ("Ying"). This rejection is traversed. Ying does not remedy the deficiencies of Iida. Ying merely describes a system for selecting, distributing and selling fonts that is capable of monitoring use of font. *See* Ying, col. 2, line 59 to col. 3, line 5. Applicants respectfully submit that for at least these reasons claim 14 is patentably distinguishable over the cited references, both alone and in combination. Therefore, Applicants respectfully request that Examiner reconsider the rejection, and withdraw it.

The Examiner also rejects claim 15 under 35 USC § 103(a) as allegedly being over Iida in view of Imai, US Patent No. 4,619,522 ("Imai"). Claim 15 has been canceled. Therefore, Applicants submit that the rejection of this claim is now moot.

The Examiner also rejects claim 17 under 35 USC § 103(a) as allegedly being over Iida in view of Steinberg, US Patent No. 6,904,168 ("Steinberg"). This rejection is traversed. Steinberg does not remedy the deficiencies of Iida. Steinberg merely describes a system for detecting pornographic images. *See* Steinberg, abstract. Applicants respectfully submit that for at least these reasons claim 17 is patentably distinguishable over the cited references, both alone and in combination. Therefore, Applicants respectfully request that Examiner reconsider the rejection, and withdraw it.

The Examiner also rejects claim 18 under 35 USC § 103(a) as allegedly being over Eaton in view of Imai, US Patent No. 4,619,522 ("Eaton"). This rejection is traversed. Eaton does not remedy the deficiencies of Iida. Eaton merely describes a system for detecting confidential terms in a document. *See* Eaton, col. 5, lines 20-27. Applicants respectfully submit that for at least these reasons claim 18 is patentably distinguishable over the cited references, both alone and in combination. Therefore, Applicants respectfully request that Examiner reconsider the rejection, and withdraw it.

The Examiner also rejects claim 19 under 35 USC § 103(a) as allegedly being over Kofman in view of Imai, US Patent No. 7,196,808 ("Kofman"). This rejection is traversed. Kofman does not remedy the deficiencies of Iida. Kofman merely describes a system for printing that is capable of optical character recognition. *See* Kofman, abstract and col. 20, lines 4-12. Applicants respectfully submit that for at least these reasons claim 19 is patentably distinguishable over the cited references, both alone and in combination.

Therefore, Applicants respectfully request that Examiner reconsider the rejection, and withdraw it.

Conclusion

In sum, Applicants respectfully submit that claims 1-21, as presented herein, are patentably distinguishable over the cited references (including references cited, but not applied). Therefore, Applicants request reconsideration of the basis for the rejections to these claims and request allowance of them.

In addition, Applicants respectfully invite Examiner to contact Applicants' representative at the number provided below if Examiner believes it will help expedite furtherance of this application.

Respectfully Submitted,
Jonathan J. Hull, Kurt W. Piersol and Peter E. Hart

Date: __May 12, 2008__   By: /Kanda Ishihara/

Kanda Ishihara, Attorney of Record
Registration No. 56,607
FENWICK & WEST LLP
801 California Street
Mountain View, CA 94041
Phone: (650)-335-7805
Fax: (650) 938-5200